

Appl. No. 10/019,178
Atty. Docket No. CM2176
Amdt. Dated December 4, 2003
Reply to Office Action of September 5, 2003
Customer No. 27752

REMARKS

Only new Claims 24 –50 are pending in the present application. Support for such Claims can be found in the original claims and specification.

Applicants' attorney reviewed Claims 1-22 and noted certain typographical errors, the use of the term preferably in such claims and that such claims could be read to extend beyond the elected subject matter. Rather than amending such claims, Applicants are submitting new Claims 24-50.

Claims 1-22 are canceled without prejudice. Claims 23 was previously cancelled by preliminary amendment.

Restriction Requirement

I. Election With Traverse

Applicants affirm the provisional election of Group XII and their traversal of the restriction requirement.

II. Basis For Traverse

The present restriction requirement is based on 35 U.S.C. § 121 and 35 U.S.C. § 372. According to 35 U.S.C. § 121 restriction requires that the inventions restricted be independent and distinct. According to MPEP § 803, a restriction requirement between patentably distinct inventions is only proper when

- 1.) The inventions are independent or distinct; and
- 2.) There is a serious burden on the Examiner if restriction is not required.

The present restriction requirement contends that the inventions claimed by Applicants lack unity of invention - there is no indication that such inventions are independent and distinct.

Applicants respectfully contend that the assertion that certain inventions lack unity of invention, without more, does not demonstrate that such inventions are independent and distinct. As a result of the foregoing, Applicants respectfully request that the present restriction requirement be withdrawn.

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Rejections Under 35 U.S.C. § 101

In the September 5, 2003, Office Action Claims 21 and 22 were rejected under 35 U.S.C. § 101. Applicants obviated such rejection by canceling such claims.

Rejections Under 35 U.S.C. § 112

In the September 5, 2003, Office Action Claims 1-22 were rejected under the second paragraph of 35 U.S.C. § 112. The Office Action states that Applicants specification is enabling for compositions which result in the formation of particles, but does not reasonably provide enablement for the use of any and all carriers with melting points of less than 30° C, and that the claims fail to include a particle making step.

Applicants obviated the rejection of Claims 1-22 by canceling such claims.

Independent Claim 24 contains a particle making limitation, Claim 32 does not contain such limitation. Regardless, Applicants assert that the aforementioned 35 U.S.C. § 112 rejection should not be applied to new Claims 24-50 as according to MPEP § 2164.01 the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. Applicants' specification discloses at page 3 that a preferred embodiment is a particle but also discloses at pages 34 and 35 that, an embodiment of Applicants' invention is a sprayable liquid. According to MPEP 2164.01(b) a single method for making and using the claimed invention may satisfy the enablement require of 35 U.S.C. § 112. Here, Applicants specification discloses multiple methods of making and suing the claimed invention and such methods include methods of making particles and liquids. In view of the foregoing Applicants contend that their specification contains sufficient teachings to enable Claims 24-50 as the skilled artisan would not have to resort to undue experimentation to practice the claimed invention.

Double Patenting Rejections

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type doctrine of double patenting as being unpatentable over Claims 1-24 of co-pending U.S. Application Serial No. 10/019,177.

Applicants obviated such rejection by canceling Claims 1-20.

Applicants contend that such rejection should not be applied to Claims 24-50 as according to MPEP § 804 (II)(B)(1) an obviousness-type double patenting rejection is appropriate only when the claimed subject matter is not patentable distinct from the subject matter claimed in a commonly owned patent or patent application. Furthermore, the analysis employed in making an

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obviousness-type double patenting rejection parallels that used to make a 35 U.S.C. § 103 obviousness determination, except that the claims of references applied need not actually be prior art.

Here, Applicants assert that the teaching of the claims of U.S. Application Serial No. 10/019,177, wherein an acid carrier is employed to aid in the incorporation of amine reaction products in fully formulated products, would not motivate the skilled artisan to employ a carrier having a melting point of below 30° C to solve such incorporation problem. In short, Applicants contend that, as there is no teaching or suggestion in the claims of the '177 application that the physical characteristics alone can be the basis for selecting an appropriate carrier, '177 does not support a judicially created obviousness-type double patenting rejection of Claims 24-50. As such, Applicants respectfully request that such rejection be withdrawn.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 24 - 50. If any outstanding issues exist, Applicants' attorney would welcome the opportunity to resolve such issues via a phone interview.

Respectfully submitted,
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